

ESTTA Tracking number: **ESTTA463903**

Filing date: **03/27/2012**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91196483
Party	Plaintiff Covert Skate, Inc.
Correspondence Address	THOMAS J BARGER COVERT SKATE INC 2428 EAST ROBINSON STREET ORLANDO, FL 32803 UNITED STATES COVERTMOT@BELLSOUTH.NET
Submission	Opposition/Response to Motion
Filer's Name	Thomas J. Barger
Filer's e-mail	covertmot@bellsouth.net
Signature	/Thomas J. Barger/
Date	03/27/2012
Attachments	Motion536anddisclosures.pdf ( 11 pages )(1748410 bytes )

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the matter of Trademark Application Serial No. 85002088  
For the mark COVERT,

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COVERT SKATE, INC  
DBA COVERT SKATE SHOP

Plaintiff,

Opposition No. 91196483

v.

KURTIS Roderick Beckstrom

Defendant.

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**536 MOTION FOR ORDER TO SHOW CAUSE**

Pursuant to Motion 536, the Plaintiff asks the TTAB to reconsider and grant motion in favor of opposition no. 91196483. The Plaintiff has attempted through discovery, with the Defendant and his counsel, to reach an agreement. The notes from the Discovery Conference of November 2010 indicate that the Defendant's counsel was to correspond with the Plaintiff within one week of the conference his intention for continuing to pursue the COVERT mark. The Defendant's counsel failed to respond.

In December of 2011, the Defendant contacted the Plaintiff through the social networking site Facebook, with a request to resolve the opposition. The Plaintiff responded in agreement to finding a resolution. However, as of February 2012, the Defendant has made no further contact.

As it shows, the Plaintiff has made effort to reach an agreement with the Defendant and his counsel regarding the COVERT mark on more than one occasion; whereas, the Defendant has not followed through.

Let the disclosures following this letter show the TTAB the Plaintiff's interest in continuing the opposition and a motion be granted in the Plaintiff's favor.



The following statements and exhibits support the Plaintiff's opposition to the Defendant's application for the mark of COVERT. The Plaintiff believes that he will be damaged by the approval of the mark to the Defendant, and hereby opposes the same. The Plaintiff asks that the TTAB dismiss the Defendant's application for the COVERT mark with prejudice.

1. Covert Skate Shop has been in business since February 2003(exhibit A).
2. Covert Skate Shop has been producing and selling its Covert merchandise since 2005(exhibit B, C).
3. Covert Skate Shop's Covert brand is sold locally in store and nationally through the Covert Skate Shop website [www.thinklivercovert.com](http://www.thinklivercovert.com) (exhibit D).
4. Covert Skate Shop is recognized the most through major search engines such as Google under the categories of Covert Skate Shop, Covert skate boards, and Covert skateboarding (exhibits E, F & G).

## Exhibit A (Division of Corporations showing initial filing date of 2/23/2003)

www.sunbiz.org - Department of State

http://sunbiz.org/scripts/cordet.exe?action=DETFIL&inq\_doc\_numb...

FLORIDA DEPARTMENT OF STATE DIVISION OF CORPORATIONS	
	
	
<a href="#">Previous on List</a> <a href="#">Next on List</a> <a href="#">Return To List</a>	
<input type="text"/>	
<input type="text"/>	
<a href="#">Events</a> <b>No Name History</b>	
<b>Detail by Entity Name</b>	
<b>Florida Profit Corporation</b>	
COVERT SKATE, INC.	
<b>Filing Information</b>	
Document Number	P03000022572
FE/EIN Number	593768580
Date Filed	02/24/2003
State	FL
Status	ACTIVE
Last Event	CANCEL ADM DISS/REV
Event Date Filed	10/26/2007
Event Effective Date	NONE
<b>Principal Address</b>	
2428 E. ROBINSON STREET ORLANDO FL 32803	
Changed 06/30/2006	
<b>Mailing Address</b>	
2428 E. ROBINSON STREET ORLANDO FL 32803	
Changed 10/26/2007	
<b>Registered Agent Name &amp; Address</b>	
BARGER, TOMMY VP 1219 YATES STREET ORLANDO FL 32804	
Name Changed: 10/26/2007	
Address Changed: 01/28/2009	
<b>Officer/Director Detail</b>	
<b>Name &amp; Address</b>	
Title P	
DURHAM, WILLIAM F 1002 E. JACKSON ST ORLANDO FL 32801	
Title VP	

## Exhibit A (Division of Corporations initial filing information continued)

BARGER, TOMMY  
1219 YATES STREET  
ORLANDO FL 32804

### Annual Reports

#### Report Year Filed Date

2008	04/28/2008
2009	01/28/2009
2010	02/19/2010

### Document Images

<a href="#">02/19/2010 -- ANNUAL REPORT</a>	<a href="#">View image in PDF format</a>
<a href="#">01/28/2009 -- ANNUAL REPORT</a>	<a href="#">View image in PDF format</a>
<a href="#">04/28/2008 -- ANNUAL REPORT</a>	<a href="#">View image in PDF format</a>
<a href="#">10/26/2007 -- REINSTATEMENT</a>	<a href="#">View image in PDF format</a>
<a href="#">06/30/2006 -- ANNUAL REPORT</a>	<a href="#">View image in PDF format</a>
<a href="#">02/22/2005 -- ANNUAL REPORT</a>	<a href="#">View image in PDF format</a>
<a href="#">04/02/2004 -- ANNUAL REPORT</a>	<a href="#">View image in PDF format</a>
<a href="#">02/24/2003 -- Domestic Profit</a>	<a href="#">View image in PDF format</a>

**Note:** This is not official record. See documents if question or conflict.

[Previous on List](#)

[Next on List](#)

[Return To List](#)

Entity Name Search

[Events](#)

**No Name History**

[Submit](#)



Exhibit B (Showing an example of COVERT branded merchandise)



Exhibit C (Invoice showing sale of COVERT branded merchandise nationally)

From  
Covert Skate Shop  
2428 East Robinson Street  
Orlando FL 32803  
407.228.0804

09/06/2008

To  
Boone Rogers  
4743 Iroquois Ave  
San Diego, CA 92117  
619.251.4359

Quantity	Description	Price	Total
1 x 8.50	COVERT digital Army Ltd. Ed. Skate Deck	\$45	\$45
	Free Adidas poster and stickers		
Shipping			\$15
Total			\$60

Thank you for your order Boone. Please call us with any questions.

COVERT SKATE SHOP staff

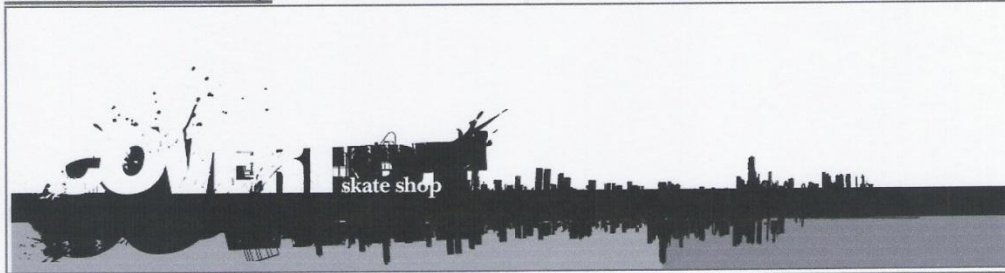
## Exhibit D (COVERT branded merchandise from Covert Skate Shop website)

Covert Skate Shop — Locals Only

<http://covertskateshop.bigcartel.com/category/locals-only>

[COVERT HOME](#)

### Covert Skate Shop



#### Locals Only



Covert -"We Are Here To Help" Tee

\$20.00



COVERT x Andrew Spear x Rock Skateboard Deck

\$40.00



Sold Out Covert-"We Are Here To Help" Board

\$40.00



Andrew Spear x COVERT Rock Tee



Exhibit E (showing Plaintiff's national recognition where "P" shows Plaintiff information and "def" shows Defendant information)

covert skate shop - Google Search http://www.google.com/search?q=covert+skateshop&ie=utf-8&oe=utf-8

Web Images Videos Maps News Shopping Gmail more ▾ marjoriewallraff@gmail.com | Web History | Settings ▾ | Sign out

Google **covert skate shop** X Search Instant is on ▾

About 217,000 results (0.15 seconds) Advanced search

Everything P

Images

Videos

News

Shopping P

More

Winter Park, FL

Change location P

Show search tools

**covert skate shop**

Fastforward to February 20, 2010 at Bold Hype art gallery where we see Covert fans here to support the shop. Big thanks to **Covert Skateshop**, Andrew Spear ... [covertskateshop.blogspot.com/](#) - Cached - Similar

**Covert Skate Shop**


Dec 20, 2010 ... For what's happening in the world of **Covert skate shop** and our immediate family. 2428 East Robinson St. Orlando FL 32803 407 228 0804 ... [www.thinklivecovert.com/](#) - Cached

**MySpace - COVERT SKATE SHOP - 19 - Male - ORLANDO, Florida ...**

Myspace profile for **COVERT SKATE SHOP** with pictures, videos, personal blog, interests, information about me and more.

Show map of 2428 E Robinson St, Orlando, FL 32803-5822

[www.myspace.com/covertskateshop](#) - Cached - Similar

 **Covert Skate Shop**


Place page

2428 East Robinson Street Orlando, FL 32803-5822 - (407) 228-0804

6 reviews - Write a review

**Videos for covert skate shop**

P


 **Covert Skateshop Welcomes Garrett Miller**

1 min - Aug 11, 2009

Uploaded by Tjgaskill

[youtube.com](#)

P

 **Covert Skate Shop Promo**

2 min - Apr 30, 2006

Uploaded by grapeyumyums

[youtube.com](#)

**Covert Skate Shop, Baldwin Park CA 91706**

Get discount coupons for **Covert Skate Shop** and other Baldwin Park, CA local merchants. Skate, Clothing, Shoes.... Great prices!!! Great service!

[www.merchantcircle.com](#) » Top » CA » Baldwin Park » 91706 - Cached - Similar

**Covert Skate Shop | Facebook**

Welcome to a Facebook Page about **Covert Skate Shop**. Join Facebook to start connecting with **Covert Skate Shop**.

[www.facebook.com/pages/Covert-Skate-Shop/86443452803](#) - Cached

**Covert Skate Shop in Orlando FL on CityVoter's Orlando Guide**

Hello, we are **COVERT SKATE SHOP**. Our address is 2428 e. Robinson St. ... **Covert Skate Shop**, Fashion Health & Fitness Health and Fitness, Men's Clothing ...

[orlando.cityvoter.com/covert-skate-shop/biz/32291](#) - Cached

**Covert Skate Shop**

2 reviews

"I love **Covert Skate Shop**...Come here for quality kicks.. If you are Nike Dunks head, then come here because they have all"

[www.insiderpages.com/b/15238117677/covert-skate-shop-orlando](#) - Cached

**Covert Skate Shop - Compton, CA**

**Covert Skate Shop** Compton reviews by real people. Yelp is a fun and easy way to find, recommend and talk about what's great and not so great in Compton and ...

[www.yelp.com/biz/covert-skate-shop-compton](#) - Cached

**Covert Skate Shop - Orlando Florida US | SkateSpotter ...**

**Covert Skate Shop** - Orlando Florida US - SkateSpotter - find skate spots, skate parks, and skate shops using google maps. Watch skateboard videos, see skate ...

[skatespotter.com/spot/orlando-covert-skate-shop-25.html](#) - Cached - Similar

**Searches related to covert skate shop**

**covert skate shop blog**

**galactic g skate shop**

1 2 3 4 5 6 7 8 9 10 Next

1 of 1 12/26/2010 8:44 PM

Exhibit F (showing Plaintiff's national recognition where "P" shows Plaintiff information and "def" shows Defendant information)

covert skateboards - Google Search http://www.google.com/search?q=covert+skateboards&ie=utf-8&oe=...

343 Web Images Videos Maps News Shopping Gmail more ▼ marjoriwallraff@gmail.com | Web History | Settings ▼ | Sign out

Google  X Search Instant is on ▼

About 8,140,000 results (0.16 seconds) Advanced search

**Everything P**  
Images  
Videos  
News  
Shopping  
More


**Winter Park, FL**  
Change location

Show search tools

**covert skate shop**  
On the night of August 18 2009 **COVERT SKATE SHOP** was robbed. An entire selection of shoes were taken, leaving only the 20 display shoes on the wall. ...  
covertskateshop.blogspot.com/ - Cached - Similar

**Covert Skateboards**  
Completely customizable **covert skateboards** from Zazzle.com - Choose your favorite **covert skateboard** decks from thousands of available designs.  
www.zazzle.com/covert+skateboards - Cached


**Shopping results for covert skateboards**


 **Dakine Covert Skate Laptop Backpack (Black)**  
\$56.99 - Amazon.com  
**COVERT 7-7/8 Skateboard Deck**  
\$49.99 - BoardPusher Skateboards  
**DAKINE Covert Backpack -1600cu in Checks / Black, One Size**  
\$39 - 5 stores

**P MySpace - COVERT SKATE SHOP - 19 - Male - ORLANDO, Florida ...**  
Myspace profile for **COVERT SKATE SHOP** with pictures, videos, personal blog, interests, information about me and more.  
Show map of 2428 E Robinson St, Orlando, FL 32803-5822  
www.myspace.com/covertskateshop - Cached - Similar

**P New COVERT Skateboards on sale now | Covert Skate Shop**  
May 21, 2010 ... For what's happening in the world of **Covert skate** shop and our immediate family. 2428 East Robinson St. Orlando Fl. 32803 407 228 0804 ...  
www.thinklivecovert.com/new-covert-skateboards - Cached

**def. Videos for covert skateboards**

 **COVERT SKATEBOARDS VIDEO "STILL BROKE" PARTS ...**  
3 min - Jul 2, 2010  
Uploaded by covertfootyupdates  
youtube.com

 **Covert Skate Shop Welcomes Chris Blake to the ...**  
Feb 9, 2010  
vimeo.com **P**

**P Covert Skate Shop in Orlando FL on CityVoter's Orlando Guide**  
Hello, we are **COVERT SKATE SHOP**. Our address is 2428 e. Robinson St. ... **Covert Skate Shop**, Fashion Health & Fitness Health and Fitness, Men's Clothing ...  
orlando.cityvoter.com/covert-skate-shop/biz/32291 - Cached

**Dakine Backpacks Covert Pack Black Alpine - snowboards**  
...  
Dakine "Covert" Skateboard Backpack. Volume-1600 cu. in. [ 26L ]; Size-19 x 13 x 7"; Max. Laptop Size-13 x 10.5 x 1.5"; Trap Door Skate Carry ...  
easternboarder.com/shop/shop.product.php?category=6&scid... - Cached

**def. COVERT SKATE AND CLOTHING STORE**  
★★★★★ 5 reviews  
"Hit up **covert**.. The hundreds obev dissizit the wild ones uoer

1 of 1 © 2010 Google 12/26/2010 8:47 PM



Exhibit G (showing Plaintiff's national recognition where "P" shows Plaintiff information and "def" shows Defendant information)

covert skateboarding - Yahoo! Search Results http://search.yahoo.com/search;\_ylt=A0oGdSWZ8RdNZ1UACxIXN...

Hi, marjoriewallraff Sign Out Help Make Yahoo! your homepage Mail

Web Images Video Local Shopping News More

**covert skateboarding** Search Options

QuickApps

View Notes

SearchScan - On P

2,970,000 results for **covert skateboarding**:

Show All

Digg

Gizmodo

We have included **conversion skateboard** results - Show only **covert skateboarding**

**covert skate shop**  
For what's happening in the world of Covert skate shop and our immediate family. ... This short from HBO does a really good job at showing you what **skateboarding** is all about covertsksateshop.blogspot.com - Cached

**Covert Skate Shop**  
For what's happening in the world of Covert skate shop and our immediate family. ... The Bernies; THE LOVE AWARENESS PROGRAM / FUCT BLOG; The Skateboard Mag; Thrasher  
www.covertskate.com - Cached

**Digg - Convert your skateboard for the ski slope**  
The Railz Conversion Kit, from Flowlab will allow your everyday, cement-loving **skateboard**. . . to carve the ski slopes. By adding 4 skis in the place of the wheels ... digg.com/news/technology/Convert\_your\_skateboard\_for\_the... - Cached

**Covert Board Shop - Upland California US | SkateSpotter ...**  
Covert Board Shop - Upland California US - SkateSpotter - find skate spots, skate parks, and skate shops using google maps. Watch **skateboard** videos, see skate photos ... skatespotter.com/spot/upland-covert-board-shop-2147.html - Cached

**Enuff 306 Covert Skateboard Trucks Low | Skateboards of Choice**  
Buy Enuff 306 Covert Skateboard Trucks Low from Skateboards of Choice: Superior **skateboard** trucks from Enuff, available in a range of frankly quite terrifying colours ... www.skateboardschoice.co.uk/enuff-306-covert... - Cached

**skateboard into longboard - Silverfish Longboarding - The ...**  
shortboard **conversion** assuming right now you have a regular **skateboard** for park/pool riding, here's what you need: - longboard wheels (if you don't want to make ... www.silverfishlongboarding.com/forum/general-long... - Cached





**Covert Skateboard Undercarriage Kit: Amazon.co.uk: Sports ...**  
Boxed-product Weight: 1.5 Kg Delivery Destinations: Visit the Delivery Destinations Help page to see where this item can be delivered. Find out more about our ... www.amazon.co.uk/Enuff-Covert-Skateboard-Undercarriage... - Cached

OhGizmo! » Archive » Railz **Skateboard Conversion Kit**  
A frequently updated blog about gadgets, innovation and design.  
www.ohgizmo.com/2006/08/30/railz-skateboard-conversion-kit - Cached

**Method for converting skateboard into springboard device ...**  
Front and rear springboard assemblies having telescoping members biased apart by springs are provided for attachment at front and rear positions to a  
www.patents.com/method-converting-skateboard-springboard... - Cached

**Railz: Convert Skateboard to Skiboard**  
[Aug 30, 2006] Railz: Convert Skateboard to Skiboard. It won't be long before the snow starts falling, and then it'll be time to convert that **skateboard** to a slope-gobbling four-runner ... ( 7 Comments )  
gizmodo.com/197709/railz-convert-skateboard-to-skiboard - Cached

**Covert Skateboarding - Image Results**

P    

1 2 3 4 5 6 7 8 9 10 11 Next >

**covert skateboarding** Search

1 of 2 12/26/2010 8:59 PM

As shown through the above exhibits, Covert Skate Shop's COVERT brand is recognized and sold nationally. Allowing the Defendant to obtain the mark will inhibit the Plaintiff's branding, and will cause further confusion among the Plaintiff's customers and vendors. The COVERT brand is the core of Covert Skate Shop's business and sales, and allowing the Defendant to obtain the mark will harm the Plaintiff's business and the name they've worked hard to build over the last nine years.

The Plaintiff respectfully asks the TTAB to dismiss with prejudice, the Defendant's claim to the COVERT mark based on the above information as well as common law. The Plaintiff also asks the board to dismiss the Defendant's claim with prejudice on basis doctrines of acquiescence and laches.

Respectfully submitted this 26<sup>th</sup> day of March, 2012

/Thomas J Barger/

Covert Skate, Inc

2428 E Robinson Street

Orlando, FL 32804

407-228-0804 shop

407-489-6467 cell

covertmot@bellsouth.net